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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,194	10/24/2000	Gary Anthony Jubb	M8540/248465	1647

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EXAMINER

GROUP, KARL E

ART UNIT PAPER NUMBER

1755

DATE MAILED: 05/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/695,194	Applicant(s) Jubb et al
Examiner Karl Group	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on May 16, 2003

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4) Claim(s) 14-23 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 14-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 19 6) Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-16-03 has been entered.

2. A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the specification does not maintain proper margins and the tables are not legible.

FURTHERMORE THE SPECIFICATION MUST MAKE REFERENCE TO THE "BRIEF DESCRIPTION OF DRAWINGS".

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 14-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14, the limitation "repeated exposures to temperatures exceeding 900 °C" is considered new matter. The term "repeated" suggests a temperature cycling which lacks support in figure 3. Also greater than 900°C is not supported, i.e. 1500°C. The original claims do not provide support for cycling temperatures at 900°C. It is agreed that tables 7 and 8 provide cycling temperatures at 1000°C and 1100°C however greater than 900°C encompasses temperatures such as 1500°C which is not supported. Neither page 4 or page 6 provides support for cycling. Applicants argue that pages 3-4 provides support for a service temperature of 900°C however the specification fails to provide support for the claim limitation "an article in applications requiring resistance against repeated exposure to temperatures exceeding 900°C". Changing the claim language to reflect the "insulation material has a service temperature above 900°C" which is lifted directly from the disclosure will overcome this rejection.

Claim 23, figure 3 lacks support for 3.5 hours or greater. This includes lengths of exposure such as 10 hours which is not contemplated. Also exceeding 900°C is new matter since this includes temperatures not contemplated such as 1500°C. Furthermore, the specification and figures are tests of the fibers not disposed on an article. It is requested that applicants point to the disclosure where the language of claim 23 "insulating an article in applications requiring resistance

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for about 3.5 hours or more". Emphasis on ARTICLE. The specification deals only with subjecting the fibers. Also where is support for times greater than 24 hours?

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 14-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Olds et al, US 5,332,699, Olds et al WO 87/05007 and Karppinen et al, each taken alone, for reasons of record.

7. The declaration under 37 CFR 1.132 filed 11-26-02 is insufficient to overcome the rejection of claims based upon the prior art as set forth in the last Office action because:

a. The declaration is based upon opinion.

b. The claims do not require subjecting the article to a temperature of 900°C and therefore the claims are not commensurate with the declaration.

Applicants argue that the prior art references fail to teach use of the claimed fibers at temperatures greater than 900°C as set forth in the preambles of claims 14 and 23. Applicants argument that the claimed fibers were not known for the claimed use is not persuasive in overcoming the rejection because the only claimed process step is disposing on an article which is taught by the prior art references.

The claim limitations requiring resistance at exposure at 900°C or greater are considered intended uses which do not further limit the claims. The only active process step set forth in the instant claims is "disposing on, in, near or around the article" which is clearly taught by the

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references. Applicants argue that the limitation to the article creates a structural difference however it is not clear what that the structural difference would be. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. If the articles are intended to be insulated at the temperatures recited in the claims it is not understood why the claims do not include an active process step requiring subjecting the articles to the temperatures. Further more the "requiring resistance" fails to quantify the resistance of the article once the thermal insulation is disposed. Further more it cannot be seen how materials of the same composition may have more heat insulation properties than the other. The fiber compositions of the prior art fall squarely within the claimed ranges. Products of identical chemical composition can not have mutually exclusive properties. *In re Spada*, 15 USPQ2d 1655,1658 (Fed. Circ. 1990). It is further argued that compositions are not being claimed but new methods of use. It should be clear that the only active process step set forth in the claims is the step of disposing. No new arguments have been presented.

c. This is a RCE of applicant's earlier Application No. 09/695194. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Group whose telephone number is (703)308-3821. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703)308-3823. The fax phone number for this Group is (703)872-9310, for any non-final amendment or communication, and (703)872-9311 for any after-final amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.



KARL GROUP
PRIMARY EXAMINER
ART UNIT 1755

Keg
May 22, 2003